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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/067,122	02/04/2002	Byoung S. Kwon	740.009US2 (IU-0008)	7406

7590            09/20/2004

Jane Massey Licata, Esquire  
Licata & Tyrrell P.C.  
66 E. Main Street  
Marlton, NJ 08053

EXAMINER

BRANNOCK, MICHAEL T

ART UNIT	PAPER NUMBER
	1646

DATE MAILED: 09/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/067,122	KWON, BYOUNG S.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Michael Brannock	1646	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 23 June 2004.
- 2a) This action is **FINAL**.
- 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 9-25 is/are pending in the application.
- 4a) Of the above claim(s) 13-16 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 9-12 and 22-25 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 04 February 2004 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 020402.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Status of Application: Claims and Amendments***

Applicant is notified that the amendments put forth on 2/4/02, 7/1/02, 9/30/02 and 6/23/04, have been entered in full.

Applicant's election (6/23/04) of Group III, is acknowledged. Applicant asserts that claims 9-12 read on the elected invention and the examiner finds that claims 22-25 also read on the elected invention.

Claims 13-16 and are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. As no arguments were presented as to why the restriction requirement might be improper, the election is treated as being made **without** traverse; thus the restriction requirement is maintained and made FINAL

### ***Specification***

The abstract of the disclosure is objected to as indicated below. Correction is required. See MPEP § 608.01(b).

Applicant is advised that the address for the ATCC has recently changed, and that the new address should appear in the specification. The new address is:

American Type Culture Collection  
10801 University Boulevard  
Manassas, VA 20110-2209

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 9-12 and 22-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention for the following reasons.

The claims require a “mouse 4-1BB”. The recited term “mouse 4-1BB”, without reference to a specific sequence identifier, is indefinite because the instant specification does not identify that material element or combination of elements which is unique to, and therefore, definitive of “mouse 4-1BB”. An artisan cannot determine what additional limitations are placed upon a claim by the presence of this term. As the instant specification provides only one example of a mouse 4-1BB (SEQ ID NO: 2) and does not appear contemplate variants that are still considered to be mouse 4-1BB, for the purpose of this examination, the broadest reasonable interpretation of the claim is that it is limited to a polypeptide of SEQ ID NO: 2.

The claims require an “antibody against mouse 4-1BB”; the word “against” renders bounds of the claim indefinite because it can be interpreted in several ways. One of ordinary skill might interpret the claim to require that the antibody simply bind against mouse 4-1BB; others may interpret the claim to require that the antibody was raised against mouse 4-1BB, the specification implies the latter interpretation (page 30, line 15), yet does not directly state this. Thus, the bounds of the claims are determined by the definition of this phrase, which has not been defined.

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Claims 9-12 and 22-23 require that the antibody "specifically recognizes an epitope". It is unclear what limitations the word "recognizes" places on the claim, i.e. is this meant to be different in scope than "binds to" as in claims 24 and 25? Thus the artisan cannot determine the bounds of the claim.

Additionally Claim 22 requires that the antibody "specifically recognizes and epitope". It appears that the word "an" should replace the word "and" in this phrase.

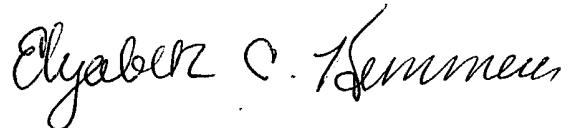
Claims 10 and 12 require a deposit at a location that is no longer exists, see above, and are thus indefinite.

#### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Brannock, Ph.D., whose telephone number is (571) 272-0869. The examiner can normally be reached on Mondays through Fridays from 10:00 a.m. to 4:00 p.m. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brenda Brumback, Ph.D., can be reached at (571) 272-0961.

Official papers filed by fax should be directed to (703) 872-9306. Faxed draft or informal communications with the examiner should be directed to (703) 308-0294.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.



ELIZABETH KEMMERER  
PRIMARY EXAMINER

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September 9, 2004